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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/025,354

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Kristina Gorhammar

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08/10/2006

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EXAMINER

MEW, KEVIN D

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

84

Office Action Summary	Application No. 10/025,354	Applicant(s) GORHAMMAR ET AL.	
	Examiner Kevin Mew	Art Unit 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-24, 26-34 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-24 and 26-32 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 33 is/are rejected.
- 7) ☒ Claim(s) 3-8, 11-18, 34 and 38-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Response to Amendment

1. Applicant's Remarks/Arguments filed on 4/10/2006 have been considered. Claims 1-8, 11-24, 26-34, 38-45 are currently pending and claims 9-10, 25, 35-37 have been canceled by applicant.

2. Acknowledgement is made of the renumbering claims 22-46 to claims 21-45 regarding the objection to the specification set forth in the previous Office Action. The corrections are acceptable and the objection to the specification has been withdrawn.

Claim Objections

3. Claim 23 is objected to because of the following minor informalities:

In claim 23, line 9, replace "said first node" by "said call control node."

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-2, 33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,775,266 (hereinafter referred as Furtenback). Note that the applicant filing of the continuing application is voluntary and not the direct, unmodified result of restriction requirement under 35 U.S.C. 121 (i.e. without a restriction requirement by the examiner) and the claims of the second application are drawn to the “same invention” as the first application or patent. Moreover, although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application merely broadens the scope of the claims 1 and 3 of the Furtenback Patent by eliminating the elements and their functions of the claims as set forth below. It has been held that the omission an element and its function is an obvious expedient if the remaining elements

perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art. Moreover, the doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent.

Regarding claims 1, 33 of the instant application, a system for providing a resource associated with an incoming call over a broadband network, comprising:

a first node including switching intelligence and narrowband switching fabric (narrowband switching node), said first node being adapted to provide the resource (speech, see Furtenback, claim 1, lines 1-2, claim 3, lines 1-3);

a plurality of second nodes each including broadband switching fabric (access node, see Furtenback, claim 1, lines 3-5), a termination one of said second nodes having first and second connections thereto associated with the call (access node having call setup signaling and per-call basis narrowband speech channels, see Furtenback, claim 1, lines 3-5, claim 3, lines 1-3); and

an interworking entity (broadband switch, see Furtenback, claim 1, lines 6-15) operatively connectable to said first node and said plurality of second nodes (broadband switch operatively connects to narrowband switching node and access node, see Furtenback, claim 1, lines 1-23), said interworking entity being adapted to configure said first connection based on instructions provided by the switching intelligence of said first node (broadband switch receives switch control message sent from the narrowband switching node, see Furtenback, claim 1, lines 17-23).

a second connection (per call basis connection, see Furtenback, claim 3, lines 1-3) thereto associated with the call (narrowband speech channel, see Furtenback, claim 3, lines 1-3) and said second connection is a temporary connection over the broadband network, the resource (speech) being provided over said temporary connection (speech is provided over the per call basis channel, see Furtenback, claim 3, lines 1-3) and wherein said interworking entity is adapted to break said call connection after said temporary connection is established to provide the bandwidth resource (narrowband speech channels are transported on and switched on a per call basis through the broadband switch, see Furtenback, claim 3, lines 1-3; note that narrowband speech on a per call basis is considered as a temporary connection).

Regarding claim 2 of the instant application, the system of claim 1, wherein said first node is comprised of a legacy switch including said narrowband switch fabric (narrowband switching node, see Furtenback, claim 1, lines 1-2).

Response to Arguments

5. Applicant's arguments with respect to claims 1-2, 33 have been considered but are moot in view of the new ground(s) of double patenting rejection. Claims 1-8, 11-24, 26-34, 38-45 would have been allowable if the double patenting rejection as set forth above can be overcome.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Mew whose telephone number is 571-272-3141. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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In claim 30, the system of claim 29, further comprising:

a frequency shift keying code sender device within said first node for generating the frequency shift keying message.

In claim 39, the method of claim 33, wherein said step of breaking further comprises the step of:

maintaining, at said termination second node, said call connection during said temporary connection.

In claim 42, the method of Claim 33, wherein said first connection is a first call connection over the broadband connection associated with an existing call and said second connection is a second call connection over the broadband network associated with the incoming call and the existing call, and wherein said step of receiving further comprises the step of:

receiving the resource at said termination second node over said second connection.

Response to Arguments

7. Applicant's arguments with respect to claims 1-5, 11, 23-24, 27-29, 33-34, 38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Mew whose telephone number is 571-272-3141. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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